



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,928	01/11/2002	Ernst Rudolf F. Gesing	Mo-6884/LcA 33871	3956
34469	7590	12/11/2003	EXAMINER	
BAYER CROPSCIENCE LP			MORRIS, PATRICIA L	
Patent Department			ART UNIT	
100 BAYER ROAD			PAPER NUMBER	
PITTSBURGH, PA 15205-9741			1625	

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,928

Applicant(s)

GESING ET AL.

Examiner

Patricia L. Morris

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-5, 8 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 8 and 10-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1625

### **DETAILED ACTION**

Claims 2-5, 8 and 10-28 are under consideration in this application.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 8 and 10-28 are rejected under 35 U.S.C. 103(a) as being obvious over the combined teachings of Muller et al. I, II and Daum et al. for the reasons set forth in Paper no. 7 and 12.

Again, Muller et al I., II and Daum et al. teach analogous compounds having the same use. Note example nos 1-44, etc., in Table 1 of Muller et al. I. The prior art compounds differ from the compound claimed herein as position isomers. Example 1 of Muller et al. I, II have the same substituents except that the ester and methyl groups are interchanged. Further, Daum et al. teach that the ester group on the thiophene ring may be at different positions on the ring. Note, for example, column 6, lines 1-17, therein. One having ordinary skill in the art would have been motivated by the disclosure of the prior art compounds To arrive at other compounds within the claimed genus. The motivation to make these compounds is their close structural similarities to the disclosed compounds. Note that the disclosed compounds have herbicidal activity, thus

Art Unit: 1625

the skilled artisan would expect such structurally similar compounds to possess similar properties.

The Declaration of Auler, filed November 12, 2003, while interesting is of little if any probative value since it is not commensurate in scope with the claims. The declaration includes only one prior art compound. Further, it is noted that the instant compound is harmful to the wheat and corn whereas the prior art compound is not. Little can be said about the many untested compounds. Table A of Muller et al. I shows that the prior art compounds have good herbicidal activity. No unexpected or unobvious results are noted.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Muller et al. I, II and Daum et al. for the reasons set forth in Paper nos. 7 and 12.

Again, Muller et al. I, II and Daum et al. disclose the instant process. Note, for example, process variant (a) in Column 3, lines 1-32 of Muller et al. I or process variant ( b) of Daum et al. As here, a sulphonamide is reacted with a triazolinone. The reaction of a specific sulphonamide with a triazolinone does not render the process step itself patentable, anew; In re Albertson, 141 USPQ 730, which was specifically reaffirmed on the last page of In re Kuehl, 177 USPQ 250.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

Art Unit: 1625

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8 and 10-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,180,567 in view of Daum et al. for the reasons set forth in Paper nos. 7 and 12.

As set forth in Paper nos. 7 and 12, the instant compounds are the position isomers of '567. Further, Daum et al. teach that the substituents on the thiophene ring may be at different positions and still retain herbicidal activity. Hence, patentable distinction is not seen.

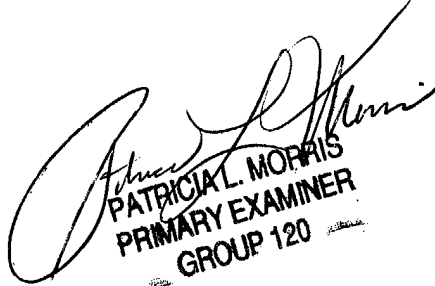
Claims 1-4, 8 and 10-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,094,683. Although the conflicting claims are not identical, they are not patentably distinct

Art Unit: 1625

from each other because the instant compounds wherein  $R^2$  is hydrogen are the position isomers of the claimed compounds therein. The instant and prior art compounds both are useful as herbicides.

***Conclusion***

No claim is allowed.

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120

plm

December 9, 2003